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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,882	10/26/2000	William A. Wandersleben	11636-002001	3702

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WINSTON & STRAWN  
PATENT DEPARTMENT  
1400 L STREET, N.W.  
WASHINGTON, DC 20005-3502

EXAMINER

NGUYEN, LE V

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 08/07/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

gm

# Office Action Summary

Application No.

09/696,882

Applicant(s)

WANDERSLEVEN ET AL.

Examiner

Le Nguyen

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. This communication is responsive to Amendment A, filed 6/3/03.
2. Claims 1-22 are pending in this application. Claims 1 and 12 are independent. This action is made Final.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Claim Rejections - 35 USC § 102*

4. Claims 1-6, 8-18 and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Watson et al. ("Watson", US 5,912,666).

As per claim 12, Watson teaches a computer program residing on a computer-readable medium, comprising instructions for causing a computer to:

display a workspace on a computer screen, the workspace having at least one toolbar including a plurality of icons that each represents a tool wherein a non-modal dialog box is displayed when an icon is chosen (fig. 8; *workspace with toolbar 830 comprising a plurality of tool icons and a non-modal dialog box associated with an icon*); and

hide or shrink the non-modal dialog box when an icon is chosen when a preferences option is enabled and a cursor is moved outside the boundaries of the non-modal dialog box wherein the non-modal dialog box is restored when a restore action occurs (fig. 8; col.8, line 31; *consistent with the definition of pull-down menus is its ability to remain available as long as a user holds it open*).

As per claim 13, Watson teaches a computer program residing on a computer-readable medium to include instruction to permit a user to disable and enable the preference option (col. 11, lines 43-44).

As per claims 14 and 15, Watson teaches a computer program residing on a computer-readable medium wherein the restore action comprises moving the cursor over a predetermined hot-spot on the workspace and the hot-spot includes at least one of a tool icon and a preference option icon (figs. 8 and 13; col. 11, lines 11-12).

As per claim 16, Watson teaches a computer program residing on a computer-readable medium wherein at least one hot-spot can be moved to a location anywhere on the workspace (col. 9, lines 57-62).

As per claim 17, Watson teaches a computer program residing on a computer-readable medium wherein the restore action is entry of a key combination (fig. 4; col. 9, lines 41-43).

As per claim 18, Watson teaches a computer program residing on a computer-readable medium wherein the cursor is centered on the restored dialog box (col. 1, lines 48-49; *wherein centering is inherent in order for users to move cursors across applications and across partitions*).

As per claim 20, Watson teaches a computer program residing on a computer-readable medium comprising instructions enabling a user to customize the preference option (col. 9, lines 52-56).

As per claim 21, Watson teaches a computer program residing on a computer-readable medium wherein a preference option properties dialog box including at least one customizable feature is provided (col. 9, lines 58-60).

As per claim 22, Watson teaches a computer program residing on a computer-readable medium wherein the customizable features include at least one of a choice of a large or small preference option box, a choice of automatically positioning a tool settings dialog, a new tool delay time, and a hide dialog delay time (fig. 8; col. 9, lines 62-63; *customizable features such as a choice of a large or small preference option box such as depicted in top right corner of 830*).

Claim 1 is similar in scope to claim 12 and is therefore rejected under similar rationale.

Claims 2 and 3 are individually similar in scope to individual claims 14 and 15 respectively and are therefore rejected under similar rationale.

Claim 4 is similar in scope to claim 16 and is therefore rejected under similar rationale.

Claim 5 is similar in scope to claim 17 and is therefore rejected under similar rationale.

Claim 6 is similar in scope to claim 18 and is therefore rejected under similar rationale.

Claim 8 is similar in scope to claim 13 and is therefore rejected under similar rationale.

Claim 9 is similar in scope to claim 20 and is therefore rejected under similar rationale.

Claim 10 is similar in scope to claim 21 and is therefore rejected under similar rationale.

Claim 11 is similar in scope to claim 22 and is therefore rejected under similar rationale.

#### ***Claim Rejections - 35 USC § 103***

5. Claims 7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson et al. ("Watson", US 5,912,666) in view of Screen Dumps of Microsoft Word 2000 ("Ms Word").

As per claim 19, Watson teaches a computer program residing on a computer-readable medium wherein the restore action is entry of a key combination (fig. 4; col. 9, lines 41-43). Watson does not explicitly disclose repeating the key combination to hide or shrink the dialog box. MS Word teaches a computer program residing on a computer-readable medium wherein the restore action is entry of a key combination and repeating the key combination shrinks the dialog box (figs. 2-5). Therefore, it would have been obvious to include MS Word's teaching of repeating a key combination to shrink a dialog box to Watson's teaching of a restore action comprising entry of a key combination in order to allow users control of a computer action without having to remember additional commands.

### *Response to Arguments*

6. Applicant's arguments in Amendment A have been fully considered but they are not persuasive.

Applicant argued the following:

(a) Watson does not teach or suggest a non-modal dialog box that can be automatically dismissed when a cursor moves off of the frame of the non-modal dialog.

(b) MS Word neither teaches shrinking a dialog box nor a restore action occurring if the same key combination is repeated.

(c) There is no suggestion or teaching to combine the Watson patent with the MS Word screen dump. Moreover, the conclusion of obviousness is based upon improper hindsight reasoning.

The Examiner disagrees for the following reasons:

As per (a), Watson teaches pull-down menus (fig. 8; col. 8, line 31). By definition, pull-down menus remain available as long as the user holds it open (*i.e. it remains open as long as the cursor is still hovering over the dialog box*). Therefore, the non-modal dialog box is automatically dismissed when a cursor moves off of the frame of the non-modal dialog box.

As per (b), MS Word teaches shrinking a dialog box and a restore action occurring if the same key combination is repeated (figs. 2-5; *key combination Ctrl+F10 shrinks a window and a restore action occurs if the same key combination is repeated*).

As per (c), in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Therefore, the key combination to resize and restore a window as taught by ubiquitous MS Word would be considered within the level of ordinary skill at the time the claimed invention was made.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Inquires*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lê Nguyen whose telephone number is (703) 305-7601. The examiner can normally be reached on Monday - Friday from 8:00 am to 5:00 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax numbers for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238 [After Final Communication]

(703) 746-7239 [Official Communication]

(703) 746-7240 [For status inquiries, Draft Communication]

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Lê Nguyen  
Patent Examiner  
July 30, 2003

*Kristine Kincaid*  
KRISTINE KINCAID  
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